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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,521	11/28/2003	Mon-Sheng Lin	BHT-3106-299	7572

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EXAMINER

ABDELWAHED, ALI F

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,521

Applicant(s)

LIN, MON-SHENG

Examiner

Ali Abdelwahed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,237,883 to Lipic in view of U.S. Patent No. 2,952,462 to Planin.

Lipic discloses a pen (A); a body (1) connected to a top of the pen and having an enclosed transparent outer shell (2), a hollow interior for holding water (see column 1, lines 8-11), a water inlet (defined by the open end of shell 2) located on an outer surface of the transparent shell and communicating with the hollow interior (see figs. 1-4), and a sealing cap (3) removably connected to and sealing the water inlet (see figs. 3, 4).

However, Lipic fails to teach at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior. Nevertheless, Planin teaches expandable toys (72, 80) that expand from an original size to an expanded size when placed in contact with water (see figs. 11, 12, and column 6, lines 17-25 and 40-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pen of Lipic, in view of Planin, such that it would provide the pen of Lipic with at least one expandable toy, as taught by Planin, in place of the object (5) located in the

hollow interior of the body for the purpose of enhancing the aesthetic and entertainment value of the ornamental pen device.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lipic in view of Planin as applied to claim 8 above, and further in view of U.S. Patent No. 5,261,848 to Kaplan et al.

Lipic, as modified, discloses the claimed invention except for the expandable toy being connected to a surface of the hollow interior of the body. However, Kaplan et al. teaches a toy (14) detachably connected to a surface of a hollow interior of a body (see fig. 3, and respective portions of the specification). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the pen of Lipic, as per the teachings of Kaplan et al., such that it would provide the pen of Lipic with the toy to being connected to a surface of a hollow interior of a body, as taught by Kaplan et al. for the purpose of enhancing the aesthetic and entertainment value of the ornamental pen device.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,237,883 to Lipic in view of U.S. Patent No. 2,952,462 to Planin and U.S. Patent No. 5,301,444 to Horiuchi.

Lipic discloses the claimed invention except for having at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior, and the expandable toy

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having a weight located at a predetermined location. However, Planin teaches expandable toys (72, 80) that expand from an original size to an expanded size when placed in contact with water (see figs. 11, 12, and column 6, lines 17-25 and 40-45), and Horiuchi teaches a decorative transparent display structure (see fig. 7) comprising a toy fish (20) disposed therein, and the toy fish having a weight (23) located within (see figs. 4, 6, 7, and column 4, lines 30-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pen of Lipic, in view of Planin and Horiuchi, such that it would provide the pen of Lipic with at least one expandable toy, as taught by Planin, in place of the object (5) located in the hollow interior of the body, and the concept of providing a weight located within the expandable toy for the purpose of enhancing the aesthetic value of the pen and providing proper balance and buoyancy to the expandable toy when the body is filled with water.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,237,883 to Lipic in view of U.S. Patent No. 2,952,462 to Planin and U.S. Patent No. 5,897,418 to Spector.

Lipic discloses the claimed invention except for having at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior, and at least one decorative sticker connected to a surface of the body, and at least one ornament connected to an interior surface of the body. However, Planin teaches expandable toys (72, 80) that

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expand from an original size to an expanded size when placed in contact with water (see figs. 11, 12, and column 6, lines 17-25 and 40-45), and Spector teaches a toy comprising at least one decorative sticker (20) connected to a surface of the body (see fig. 5), and at least one ornament (defined by the decorative label 20) connected to an interior surface of the body (see column 2, lines 60-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pen of Lipic, in view of Planin and Spector, such that it would provide the pen of Lipic with at least one expandable toy, as taught by Planin, in place of the object (5) located in the hollow interior of the body, and at least one decorative sticker/ornament connected to a surface or an interior surface of the body, as taught by Spector for the purpose of enhancing the aesthetic value of the pen.

Claims 14-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,498,074 to Feldman in view of U.S. Patent No. 5,897,418 to Spector and U.S. Patent No. 5,350,058 to Keough.

Feldman discloses the claimed invention except for the body having a carrying handle connected thereto, a sealing cap to seal the water inlet, the expandable toy being connected to a surface of the hollow interior of the body, at least one decorative sticker connected to a surface of the body, and at least one ornament connected to an interior surface of the body. However, Spector teaches a toy comprising a cap (19), the expandable toy being connected to a surface of the hollow interior of the body (see figs. 4, 5, the expansive toy is connected to a surface of the hollow interior of the body

through a friction fit between the arms of the expansive toy and the walls of the container), at least one decorative sticker (20) connected to a surface of the body (see fig. 5), and at least one ornament (defined by the decorative label 20) connected to an interior surface of the body (see column 2, lines 60-64); and Keough teaches a toy pet container having a carrying handle (38) connected thereto (see figs. 1, 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the toy of Feldman, in view of Spector and Keough, such that it would provide the toy of Feldman with a carrying handle connected thereto, as taught by Keough, a sealing cap to seal the water inlet, the expandable toy being connected to a surface of the hollow interior of the body upon expanding and forming a friction fit, and at least one decorative sticker/ornament connected to a surface or an interior surface of the body, as taught by Spector, for the purpose of enhancing the versatility and aesthetic value of the toy.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman in view of Spector and Keough as applied to claim 14 above, and further in view of U.S. Patent No. 5,301,444 to Horiuchi.

Feldman, as modified, discloses the claimed invention except for the expandable toy having a weight located at a predetermined location. However, Horiuchi teaches a decorative transparent display structure (see fig. 7) comprising a toy fish (20) disposed therein, and the toy fish having a weight (23) located within (see figs. 4, 6, 7, and column 4, lines 30-35). Therefore, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to further modify the toy of Feldman, as per the teachings of Horiuchi, such that it would provide the toy of Feldman with the concept of providing a weight located within the expandable toy for the purpose of providing proper balance and buoyancy to the expandable toy when the container is filled with water.

Response to Arguments

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (571) 272-4417. The examiner can normally be reached Monday through Friday from 10:00 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA
10/22/2004


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